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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/306,761	05/07/1999	JACK DENEBERG	12177/47501	3926

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[REDACTED]  
EXAMINER

LE, LANA N

ART UNIT	PAPER NUMBER
2684	

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/306,761	DENEBERG ET AL. <i>[Signature]</i>
	Examiner Lana Le	Art Unit 2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 22 February 2002.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-8 and 10-15 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-8 and 10-15 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## **RESPONSE TO AMENDMENT**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-8, and 10 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1, 6, 11-12, 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by

Donovan et al (US 5,940,589).

Regarding claim 1, Donovan et al discloses a method for registering a mobile communication device to a service comprising:

receiving device identifier for the mobile communication device via a first communication network; wherein the device identifier provides information which the mobile communication device is capable of receiving (col 5, lines 25-35);

receiving via the first network 82, a request from mobile 81 (figure 4) for a first service to be provided to the mobile communication device (col 3, lines 60-63);

accessing a device capabilities database HLR 87 using the received device identifier (col 3, lines 63-67);

and when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device (col 4, line 52 – col 5, line 53).

Regarding claim 6, Donovan et al discloses a method for registering a mobile communication device to a service comprising:

receiving a device attribute (profile information; figure 4) for the mobile communication device via a first communication network, wherein the device attribute provides information which the mobile communication device is capable of receiving;

receiving via the first network a request for a first service to be provided to the mobile communication device (col 3, lines 60-63);

accessing an attribute database 83 using the received device attribute;

determining whether the mobile communication device is determined to be permitted to receive the requested service, setting up the requested service for the mobile communication device (col 4, lines 52 – col 5, line 53).

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Regarding claim 11, Donovan et al discloses a program storage device 86 readable by a machine, tangibly embodying a program of executable instructions to perform a method for registering a mobile communication device to a service (fig. 3; col 5, lines 14-35), the method comprising: receiving device identifier for the mobile communication device via a first communication network 82, wherein the device identifier provides information which the mobile communication device is capable of receiving (col 5, lines 25-35); receiving, via the first network, a request for a first service to be provided to the mobile communication device (col 3, lines 60-63); accessing a device capabilities database using the received device identifier (col 3, lines 63-67); determining whether the mobile communication device is capable of receiving the requested service; and when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device (col 4, line 52 –col 5, line 53).

Regarding claim 12, Donovan et al discloses a program storage device readable by a machine, tangibly embodying a program of executable instructions to perform a method for registering a mobile communications device to a service (fig. 3; col 5, lines 14-35), the method comprising: receiving a device attribute (profile information; figure 4) for the mobile communication device via a first communication network, wherein the device attribute provides information which the mobile communication device is capable of receiving; receiving, via the first network, a request for a first service to be provided to the mobile communication device (col 3,lines 60-63); accessing an attribute database using the received device attribute (col 3,lines 63-67); determining whether the mobile

communication device is permitted to receive the requested service; and when the mobile communication device is determined to be permitted to receive the requested service, setting up the requested service for the mobile communication device (col 4, line 52 – col 5, line 53).

Regarding claim 14, Donovan discloses a method for activating a mobile communication device to a service comprising: receiving device identifier for the mobile communication device, the device identifier representing a type of equipment IMEI represented by the mobile communication device (col 5, lines 15-35); receiving a request for a first service to be provided to the mobile communication device; accessing a device capabilities database 83 using the received device identifier (col 3, lines 60-63); determining whether the mobile communication device is capable of receiving the requested service (col 3, lines 63-67); and when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device (col 4, line 52 – col 5, line 53).

Regarding claim 15, Donovan et al discloses a method for registering a mobile communications device to a service, comprising, upon activation of the mobile communications device with a service provider: receiving a device attribute (profile information; figure 4) for the mobile communication device; receiving a request for a first service to be provided to the mobile communication device (col 3, lines 60-63); accessing an attribute database using the received device attribute (col 3, lines 63-67); determining whether the mobile communication device is permitted to receive the requested service; and when the mobile communication device is

determined to be permitted to receive the requested service, setting up the requested service for the mobile communication device (col 4, line 52 – col 5, line 53).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Donovan et al in view of Wild et al (US 5,862,480).

Regarding claim 2, Donovan et al didn't disclose further wherein when it is determined that the communication device is not capable of receiving the requested service, proposing an alternative service to the party that requested service wherein the alternative service is compatible with the mobile communication device. Wild et al discloses wherein when it is determined that the communication device is not capable of receiving the requested service, proposing an alternative service to the party that requested service wherein the alternative service is compatible with the mobile communication device (col 10, lines 8-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the alternative service to Donovan et al in order to provide for the mobile requester to choose another low service rate plan that's convenient for him/her.

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2. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donovan et al in view of Fehnel (WO 97/34438).

Regarding claim 4, Donovan et al didn't specifically disclose the device capabilities database stores information about whether the mobile unit is a multi-network phone and the mobile unit is determined to be capable of receiving the service when the device capabilities database indicates that the mobile unit is a multi-mode phone. Fehnel further discloses the subscriber profile can indicate whether the mobile is digital capable (page 20, lines 1-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the subscriber profile of Donovan et al to have the multi-mode indication as in the subscriber profile of Fehnel in order to determine if the phone is capable of multiple modes.

Regarding claim 7, Fehnel discloses further the method of claim 6, the device attribute comprises an electronic serial number (ESN) associated with the device, the attribute database including an indication of whether a device having a particular ESN is a multi-network phone; and

the mobile communication device is permitted access to the requested service if there is an indication in the attribute database that the device is a multi-network phone (page 20, lines 3-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the subscriber profile of Donovan et al to have the multi-mode indication as in the subscriber profile of Fehnel in order to determine if the phone is capable of multiple modes.

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2. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donovan et al (US 5,940,589) in view of Frager (US 6,018,652).

Regarding claim 3, Donovan et al didn't disclose the method of claim 1 wherein the requested service comprises a billing plan for communications using the mobile communication device (col 2, lines 60-67). Frager discloses the method of claim 1 wherein the requested service comprises a billing plan for communications using the mobile communication device (col 2, lines 60-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the billing plan of Frager to Donovan et al in order to determine the charges for different types of cellular phones and if the particular phone is eligible for the special service that was sought.

Regarding claim 5, Frager discloses further the method of claim 4 wherein the requested service comprises a billing plan for communications using the mobile communication device (col 2, lines 60-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the billing plan of Frager to Donovan et al in order to determine the charges for different types of cellular phones and to determine if the particular phone is eligible for the special pricing service that was requested.

3. Claims 8, 10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donovan et al in view of Frager (US 6,018,652).

Regarding claim 8, Donovan et al didn't disclose further the device attribute includes a home location identifier to be associated with the mobile communication device;

the mobile communication unit is allowed access to the requested service if there is an indication in the attribute database that the home area of the mobile communication corresponds to a geographic area in which the service is receivable; and the mobile communication device is permitted access to the requested service if there is an indication in the attribute database that the home location of the mobile communication device corresponds to a geographic area in which the service is receivable; and the mobile communication device is permitted access to the requested service if there is an indication in the attribute database that the home location of the mobile communication device corresponds to a geographic area in which the service is receivable. Frager et al discloses the device attribute includes a home location identifier to be associated with the mobile communication device (col 5, lines 15-21); the mobile communication unit is allowed access to the requested service if there is an indication in the attribute database that the home area (a cell or a number of cells 18 in geographic area 16) of the roaming mobile of the mobile communication corresponds to a geographic area 16 in which the service is receivable; and the mobile communication device is permitted access to the requested service if there is an indication in the attribute database that the home location of the mobile communication device corresponds to a geographic area in which the service is receivable (col 3, lines 23-41). It would have been obvious to one of ordinary skill in the art to add the home location in order to provide the special discount service only to those that belongs to the predefined region such as the home area of the mobile subscriber.

Regarding claim 10, Donovan et al discloses a method for ascertaining whether to register a mobile communication device to a given service, the method comprising:

applying a device identifier to an equipment capabilities filter and registering the mobile communication device to the given service if the device identifier pass through the equipment capabilities filter (col 4, line 52 – col 5, line 35).

Donovan et al didn't disclose applying a home location identifier to a geographic eligibility filter; and registering the mobile communication device to the given service if the home location identifier pass through the geographic eligibility filter. Frager et al discloses applying a home location identifier to a geographic eligibility filter; and registering the mobile communication device to the given service if the home location identifier pass through the geographic eligibility filter (col 5, lines 32-46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the home location identifier to Donovan et al in order to provide a special reduced rate for subscribers that are within a certain home region of the cellular service area.

Regarding claim 13, Donovan et al discloses a program storage device readable by a machine (fig. 3; col 5, lines 14-35), tangibly embodying a program of executable instructions to perform a method for ascertaining whether to register a mobile communication device to a given service (col 3, lines 52 – col 4, line 9), applying a device identifier to an equipment capabilities filter (col 4, lines 52 – col 5, line 35); and registering the mobile communication device to the given service if the device identifier pass through the equipment capabilities filter (col 5, lines 14-18).

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Donovan et al doesn't disclose further the method comprising: applying a home location identifier to a geographic eligibility filter; and registering the mobile communication device to the given service if the home location identifier pass through the geographic eligibility filter. Frager further discloses the method comprising: applying a home location identifier to a geographic eligibility filter in which only the predefined home region 18 in geographic area 16 is applied; and registering the mobile communication device to the given service if the device identifier and home location identifier pass through the geographic eligibility filter (col 3,lines 23-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the home location identifier to Donovan et al in order to provide a special reduced rate for subscribers that are within a certain home region of the cellular service area.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lana Le whose telephone number is (703)308-5836. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Hunter can be reached on (703)308-6732. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9314 for regular communications and (703)872-9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-6750.

Lana Le

June 14, 2002



DANIEL HUNTER  
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